

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN T. STOYCOS and EWIN MICHAEL KISER

Appeal No. 2004-0896
Application No. 09/751,774

ON BRIEF

MAILED

MAR 31 2004

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before WALTZ, KRATZ and PAWILOWSKI, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-24, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a method of accessing a study record taken during a cardiac catheterization procedure. The method can allow for the real time access to displayed data on a plurality of workstations during a cardiology procedure. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of accessing a study record taken during a cardiac catheterization procedure, the procedure being conducted in a cardiac catheterization lab, comprising the acts of:

(a) inserting at least one catheter into a patient comprising a heart, catheters terminating in a position proximate to the heart and comprising one or more sensors configured to sense data from the heart;

(b) stimulating the heart with electrical signals from the catheter;

(c) sensing data from the heart;

(d) transmitting the data from the sensors to a data collection device;

(e) transmitting the data from the data collection device to a central publisher;

(f) replicating the data;

(g) transmitting the replicated data from the central publisher to a plurality of client workstations; and

(h) simultaneously displaying the data on the plurality of client workstations.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Budd et al.	5,662,108	Sep. 02, 1997
Soukal	6,035,328	Mar. 07, 2000

Claims 1-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Soukal in view of Budd.

We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by appellants and the examiner concerning the issues before us on this appeal.

DECISION AND OPINION

We reverse.

A central question before us is whether the examiner's assertion of inherency with respect to the Soukal reference is reasonable. We answer that question in the negative since the examiner has not provided a sufficient basis in fact and/or technical reasoning to reasonably support the examiner's assertion (answer, page 4) concerning the allegedly inherent performance of the claimed process steps, including the replicating step, as necessarily flowing from the teachings of the applied prior art. See Ex parte Levy, 17 USPQ 1461, 1464 (Bd. Pat. App. & Int. 1990).¹

Concerning this matter, we observe that Soukal describes a medical therapeutic and/or diagnostic system including at least one operating means including computing means allocated thereto, and a control means communicating therewith for controlling the operation. Exemplary therapeutic and/or diagnostic systems described as prior art in Soukal (column 1, lines 13-18) include

¹ The examiner's obviousness position advanced in the rejection before us hinges on the examiner's assertion of inherency with respect to Soukol's disclosed therapeutic and diagnostic system.

X-ray and shock wave systems. Soukal (column 1, lines 40-47) teaches that:

at least a part of the operating and/or processing data previously stored in the computing unit of the operating means, i.e., the system's specific technical software, is not stored there anymore, but rather is only implemented in the control means, which delivers the software to the operating means only as needed, such as in the startup of the operating means or the like.

In the drawing figure, Soukal depicts an arrangement employing a number of operating units, including intranet connected units and external operating means (11) that require use of a public network, i.e., the Internet, for connection. At column 3, lines 29-34, Soukal further provides that:

[t]he communication between the operating units 4 and 6 and the control unit 8 ensues via an HTTP protocol, so that the control unit 8 acts as an HTTP-server, which places the necessary operating and/or processing data, i.e., the respective software, at the operating unit side, at one's disposal as needed.

From the above passages, it is clear that Soukal is concerned with software exchange and storage for use in the operating means as argued by appellants (brief, page 7, first full paragraph), not data acquired during a test procedure. The examiner refers to column 1, lines 54-56 of Soukal for a teaching of data transmission. However, as evident from the passages

reproduced above, Soukal use the term "exchange of data" as that term relates to operating or processing data (software). Moreover, the examiner (answer, page 4) acknowledges that applicants provide more detail in disclosing their system than does Soukal. Consequently, the examiner has not shown that Soukol describes a control and operating system identical with or substantially the same as appellants' system so as to support the examiner's position that operating Soukal's system necessarily results in steps being performed that correspond to the data handling steps (d) through (h) of claim 1.²

The examiner, in relying on a theory of inherency, must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art. See In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The examiner has not provided persuasive support for an inherency theory. Inherency cannot be established based on conjecture and/or probabilities or possibilities. See In re Oelrich, 666 F.2d 578, 581, 212 USPQ

² The examiner additionally relies on Budd to show a catheterization procedure. The examiner does not rely on Budd to suggest appellants' data processing method steps.

323, 326 (CCPA 1981); Ex parte Skinner, 2 USPQ2d 1788, 1788-1789 (Bd. Pat. App. & Int. 1986).

On this record, we will not sustain the examiner's rejection.

REMAND

We note that appellants refer to prior techniques in the Background of Related Art section of their specification, including the need for consultation with multiple clinicians and the use of techniques, such as fax machines, to communicate data from an electrophysiology (EPS) study to clinicians at remote sites (specification, page 4). Prior to final disposition of this application and if not already investigated, the examiner, with appellants' help, should determine if the prior techniques referred to in the specification represent prior art to appellants' claimed invention. If so, the examiner should determine the full extent of those prior art teachings. Thereafter, the examiner should consider whether or not those prior art teachings in combination with Budd taken with any other known prior art, including Soukal, would have led (provided both the incentive and a reasonable expectation of success) one of ordinary skill in the art to transmit, replicate and display

CONCLUSION

REVERSED/REMANDED

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Appeal No. 2004-0896
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Page 8

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